

REMARKS

The Official Action of April 1, 2003 has been carefully considered and reconsideration of the application as amended is respectfully requested.

The acknowledgment of priority at paragraph 2 of the Official Action has been noted. Applicants submit herewith a substitute Declaration which references the two priority applications. Certified copies of these priority applications will follow.

Claim 16 has been amended to correct its dependency and thereby to remove the basis for the rejections under 35 USC 112, second paragraph, appearing at paragraph 4 of the Official Action. New claims 30-35 have been added more completely to cover the subject matter which Applicants regard as their invention. Support for the new claims appears in the Examples on pages 86-143 of the specification which show the separate preparation of a pigment dispersion prior to admixture of the pigment dispersion with additional components to form a recording liquid. The Examples also show the respective amounts of the solid and liquid components of the pigment dispersion and recording liquid as claimed. The recitation that the recording liquid comprises a solvent and surface active agent is also described in the specification at, for example, page 3, lines 10-11. All claims presently on file are believed to be sufficiently definite to satisfy the dictates of 35 USC 112, second paragraph.

Certain claims stand rejected under 35 USC 103(a) as allegedly being unpatentable over combinations of references that rely on Komatsu et al, US Patent 6,524,383 (see paragraphs 6 and 7 of Official Action). Applicants respectfully traverse these rejections.

It is respectfully noted that Komatsu et al US Patent 6,524,383 issued from a US application that was a continuation-in-part of an international application. As noted in MPEP Section 706.02(f)(1), an international filing date which is on or after November 29, 2000 may have effects under 35 USC 102(e) if and only if the international application designated the US and was published under Article 21(2) of the (PCT) treaty in the English language. However, the international application in Komatsu et al was **not** published in English under PCT Article 21(2) such that the 102(e) date of the reference is the actual US filing date (i.e., October 19, 2001). This is after the filing date of the present application such that Komatsu et al is not citable as prior art against the claimed invention under the provisions of 35 USC 102(e) or 35 USC 103(a) via 102(e).

Komatsu et al also is not citable as prior art against the claimed invention under the provisions of 35 USC 103(c) due to common ownership of the relevant subject matter. In this connection, the undersigned makes the following statement on behalf of Applicants:

The present application and Komatsu et al US Patent 6,524,383 were, at the time

the invention of the present application was made, owned by or subject to an obligation of assignment to Seiko Epson Corporation.

In view of the above, Komatsu et al is not properly citable against the claimed invention and it is respectfully submitted that the rejections of record that rely on Komatsu et al should be withdrawn.

Certain other claims have been rejected under 35 USC 103(a) as allegedly being unpatentable over Satake et al in view of Osumi et al and Ichizawa et al or over Satake et al in view of Johnson et al, Osumi et al and Ichizawa et al. Applicants respectfully traverse these rejections.

The invention, as defined in claim 1 and the claims depending therefrom, recites a method of making **a pigment dispersion** that includes the incorporation of a resin for providing dispersibility and/or fixability. By contrast, in the primary reference cited by the Examiner, Satake et al, it is evident that the resin referred to by the Examiner in the rejection (see Satake et al at column 3, line 25 *et seq*) is added during preparation of an ink jet recording liquid **after** the pigment dispersion has already been prepared. This is evident when viewing the Examples in Satake et al.

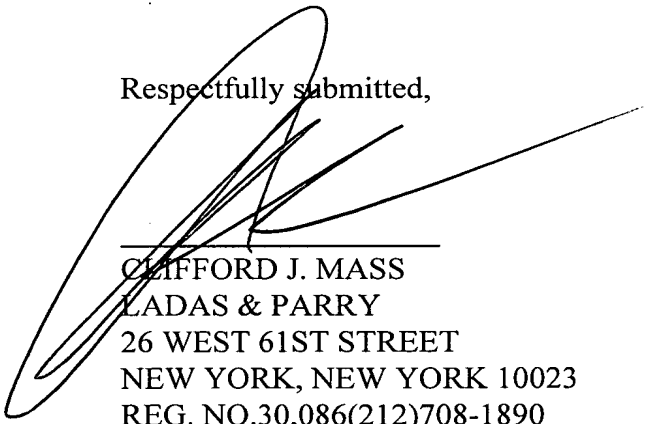
Specifically, in Emulsion Preparation 1 and Emulsion preparation 2-3, emulsions of aqueous dispersion-type resin were prepared. Example 1 is the one and only Example in which a pigment dispersion was prepared. All the other Examples

relate to the preparation of an ink jet recording liquid using the pigment dispersion with the subsequent addition of an emulsion of an aqueous dispersion-type resin.

Although, as noted in the specification of the present application at page 60, lines 7-9, there are cases where the claimed pigment dispersion may also be used as an ink jet recording ink, this does not mean that the recording ink described in Satake et al can be considered to be a pigment dispersion. In fact the reference clearly distinguishes between a pigment dispersion and the recording liquid made therefrom. Accordingly, it is respectfully submitted that the Examiner cannot rely upon a combination of references based on Satake et al to render obvious the claimed invention. This is *a fortiori* true with respect to claims 30-35, wherein additional recitations further distinguish the claimed pigment dispersion from the pigment dispersions and recording inks described in Satake et al.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



CLIFFORD J. MASS
LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG. NO.30,086(212)708-1890

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Claim 16 (amended) The process for the preparation of a pigment dispersion according to Claim 1 [15], wherein [the amount of] Si, Ca, Mg, Fe, Cr and Ni ions [to be] incorporated in the liquid component of the pigment dispersion [thus prepared] are each not higher than 100 ppm.